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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Mehmet Toner et al.
Application No: 09/443,842 - 7776
Filing Date: November 19, 1999
Entitled: **CONTROLLED REVERSIBLE
PORATION FOR PRESERVATION
OF BIOLOGICAL MATERIALS**
Atty. Docket No: 22727-41

Group Art Unit: 1651

Examiner: V. Afremova

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12/7/01

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By:

Ronald E. Cahill
Reg. No: 38,403

RESPONSE TO RESTRICTION REQUIREMENT

Box Non-Fee Amendment
Commissioner for Patents
Washington, DC 20231

Dear Sir:

In response to the Office Action dated September 26, 2001, Applicants respond as follows:

The Office Action

The September 26, 2001 Office Action contains only a restriction requirement. Currently, claims 37 to 102 are pending in the application with 5 independent claims: 37, 49, 62,

73, and 90. Each of these claims recites features that were previously pending either in the claims of the present application before amendment, or in the present application's direct parent which has now issued as United States Patent No. 6,127,177. Despite the fact that these features have already been searched and argued in this application and its parent, the Examiner imposes a five-way restriction requirement, restricting Applicants to a single independent claim per Group:

Group I:	Independent claim 37; dependent claims 38 to 48;
Group II:	Independent claim 49; dependent claims 50 to 61;
Group III:	Independent claim 62; dependent claims 63 to 72;
Group IV:	Independent claim 73; dependent claims 74 to 89; and
Group V:	Independent claim 90; dependent claims 91 to 102.

Provisional Election

Applicants provisionally elect group IV, claims 73 to 89, with traverse.

Traversal

Applicant is entitled to examination of at least groups III, IV, and V in this application.

For the purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02. That *prima facie* showing may be rebutted by appropriate showings or evidence by the applicant. MPEP § 808.03
Restriction – When Proper.

To the extent that the Examiner has provided a *prima facie* case that the claims of Groups III, IV and V require independent searches because they require separate classification, Applicants rebut that *prima facie* case below.

According to the Examiner's restriction requirement, the inventions of each of the independent claims:

are independent and distinct, each from the other. They have acquired a separate status in the art as a separate subject for inventive effect and require independent searches (as indicated by

different classification). The search for each of the above inventions is not co-extensive particularly with regard to the literature search. Further, a reference which would anticipate one group would not necessarily anticipate or make obvious the other group.

This argument does not hold true. As even the Examiner has admitted, the inventions of groups III and V are of the same class and subclass: class 435, subclass 374. In fact class 435, subclass 374 ("Method of storing cells in a viable state") provides a fully adequate classification for each and every claim in the pending application.

The Examiner argues that the claims of Group IV (described as "drawn to a method for preserving nucleated cells having lipid membranes") should be classified in class 435, subclass 325 – a different classification than for Groups III and V. Class 435, subclass 374 (the classification for Groups III and V) fully describes the subject matter of the Group IV claims (the examiner describes the Group as "drawn to a method for preserving nucleated cells having lipid membranes" and 435/374 is directed to "Method of storing cells in a viable state"). The Examiner's proposed classification for the Group IV claims, class 435, subclass 325 (directed to "Animal cell, per se (e.g., cell lines, etc.); composition thereof; process of propagating, maintaining or preserving an animal cell or composition thereof; process of isolating or separating an animal cell or composition thereof; process of preparing a composition containing an animal cell; culture media therefore") is merely the parent classification to 435/374, and only includes irrelevant information with respect to the Group IV claims beyond that already included in 435/374 ("Method of storing cells in a viable state").

The Examiner implicitly recognized this in the parent case, which also included claims to preserving nucleated cells (see independent claims 1 and 10 of US Patent No. 6,127,177) just as the Group IV claims do; yet in the parent case, the Examiner classified the patent in 435/374; 435/1.3; 435/2; and the field of search was 435/374, 1.3, 2. The class/subclass combination proposed by the Examiner for Group IV in the restriction requirement (435/325) was not searched and was not a classification for the parent patent despite the fact that its independent

claims contain the same recitations as the Group IV claims. By the Examiner's own admissions and previous actions, Groups III, IV and V belong to the same class/subclass: 435/374. Accordingly, the Examiner's argument that independent searches are required does not hold.

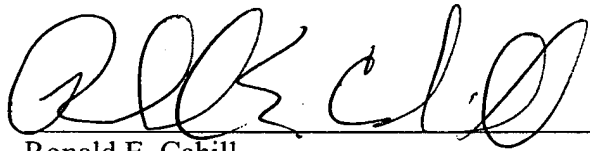
In addition, in order to examine the Group IV claims, the Examiner will necessarily have to search the features that purportedly distinguish Group III and V claims from those of Group IV. For example, claim 76 (of Group IV which depends from independent claim 73) recites that the cell membranes are "porated using a membrane toxin" just as the Group V claims are. Similarly, claim 82 (of Group IV, depending from claim 73 through claims 81 and 80) requires that the bio-preservation agent consists essentially of a non-permeating sugar, just as the Group III claims do. Accordingly, searching Group III, IV and V claims together will not pose any additional burden on the Examiner.

Conclusion

For all of the foregoing reasons, Applicants submit that claims 62-102 (Groups III, IV and V) should be examined, and, as explained in Applicants' July 2, 2001 Amendment and Response, are in condition for allowance. Applicants respectfully request a notice of allowance for these claims. Applicants further request that the Examiner telephone the undersigned Attorney for Applicants in the event that such communication might expedite prosecution of this matter.

Respectfully submitted,

Date: 12/7/01



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